

REMARKS

This Amendment, submitted in response to the Office Action dated October 26, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

I. Rejection of claims 1-8 and 17-24 under 35 U.S.C. § 101

The Examiner has rejected claims 1-8 and 17-24 asserting that the claims are directed to non-statutory subject matter. Further, the Examiner requires amending the claims to recite "computer implemented." The claims have been amended as indicated above, as has claim 27. Consequently, Applicant respectfully requests that the rejection of claims 1-8 and 17-24 be withdrawn.

II. Claim Rejections under 35 U.S.C. § 102

Claims 1-2, 9-10 and 17-18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Dedrick (U.S. Patent No. 5,768,521). It is respectfully submitted that claims 1-2, 9-10 and 17-18 are patentable over Dedrick for at least the following reasons.

Claims 1-2, 9-10 and 17-18

Claim 1 recites:

"A method for determining the cost of a **content object** having a plurality of content entities, comprising the steps of determining a **content count** for the content object and determining from the content count a price for the content object."

Dedrick discloses a general purpose metering mechanism for the distribution of electronic information from a server to a client computer. Content in a database such as newspapers and magazines can be provided from a publisher to a user for a predetermined cost.

A client is charged according to a metering mechanism which meters the flow of information to a client computer. Col. 1, lines 62-65.

The Examiner asserts that Dedrick col. 1, line 62-col. 2, line 22 and col. 4, line 26-col. 5, line 25 teaches all the elements of claim 1. The respective column and lines cited by the Examiner describe a metering mechanism which meters the flow of information from a server to a client computer. That portion of Dedrick discloses that a client can be charged for the services monthly, yearly, a one time charge, pay per view, per byte, or per time.

Claim 1 recites “a method for determining the cost of a content object having a plurality of content entities.” The Examiner asserts that Dedrick discloses a database that corresponds to the claimed content object and that the units of information (i.e. text, video, advertisements) disclosed in Dedrick corresponds to the claimed plurality of content entities.

Claim 1 further recites “determining a *content count* for the content object.” The Examiner asserts that Dedrick “counts” the units of the content object in order to calculate a cost to charge the user. In order to anticipate the claims, the Examiner must establish that each and every element is disclosed in the cited art. However, Applicant respectfully submits that the Examiner has failed to identify where a “count” is disclosed in Dedrick.

Dedrick discloses calculating a cost per view, per byte or per time. Dedrick does not disclose determining a content count for a content object. In Dedrick, the user is charged for the units of information selected from the database. There is no indication that a count of the contents in the database is performed.

Claim 1 further recites “determining from the content count a price for the content object.” As previously indicated, the user is charged for the units of information retrieved from

the database. It is respectfully submitted that Dedrick does not disclose determining a price for a content object according to a *content count*.

The Examiner appears to concede that Dedrick does not explicitly disclose determining a price for a content object according to a *content count*, and asserts that determining a price for a content object according to a content count is inherent in Dedrick. In particular, in the Advisory Action dated May 13, 20005, the Examiner states:

"The Examiner finds it highly unlikely that Dedrick would restrict a user to acquire only one unit of information at a time in the case of the "per byte" and "per time" pricing. If single unit acquisition was in fact implemented and the user wanted to acquire a 5MB file in a price per MB pricing scheme, the user would have to make five separate requests to acquire one single file."

However, the Examiner's own statement contradicts the Examiner's inherency argument.

In relying upon the theory of inherency, the Examiner must show that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art. However, the Examiner admits in the Advisory Action that single unit acquisition could be implemented although it would require a user to make several separate requests. Consequently, it is not inherent that Dedrick determines from the content count a price for the content object, since separate single unit requests are possible.

Because Dedrick fails to disclose or suggest any such cost determination of a content object, claims 1, 9 and 17 are not anticipated by Dedrick. Consequently, dependent claims 2-8, 10-16, and 18-27 are not anticipated by Dedrick.

III. Rejection of claims 3-6, 11-14, 19-22 and 25-27 under 35 U.S.C. § 103(a)

Claims 3-6, 11-14, 19-22 and 25-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick.

Claims 3-6, 11-14, 19-22 and 25-27

Claims 3-6, 11-14, 19-22 and 25-27 should be deemed patentable by virtue of their dependency to claims 1, 9, and 17 for at least the reasons set forth above. Since Dedrick does not even teach the elements of claims 1, 9 and 17, the elements of dependent claims 3-6, 11-14, 19-22 and 25-27 are not made obvious in view of Dedrick.

IV. Rejection of claims 7-8, 15-16 and 23-24 under 35 U.S.C. § 103(a)

Claims 7-8, 15-16 and 23-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of Khan et al. (U.S. Patent No. 6,199,054).

Claims 7-8, 15-16 and 23-24

Claims 7-8, 15-16 and 23-24 should be deemed patentable by virtue of their dependency to claims 1, 9, and 17 for at least the reasons set forth above. Moreover, Khan does not cure the deficiencies of Dedrick.

Khan is directed to a system and method for computing costs associated with Internet based content delivery. In particular, Khan is directed to a system and method of charging users for the sending of e-mails similar to the system used by the United States Postal Service of charging users for the sending of regular mail. A cost is computed according to the transmission of user specified data files. See Khan claim 1. At no point does Khan disclose determining a content count for a content object, as recited in Applicant's claim 1.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/489,143

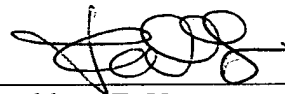
Attorney Docket No.: A8521

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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